

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 13, 2005. Claims 1, 5-10, 19 and 22-29 are pending in the Application. Claims 1, 5-10, 19, 22-24 and 26-29 are rejected and Claim 25 is objected to. For at least the reasons discussed below, Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1, 5-7, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,711,125 issued to Walrand et al. ("*Walrand*") in view of U.S. Patent No. 6,226,111 issued to Chang et al. ("*Chang*").

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained at least because (even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention) *Walrand* and *Chang*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, fail to disclose all of the elements of the pending claims.

For example, Claim 1 recites "generating a first protection path . . . ; generating a second protection path . . . , the second protection path distinct from the first protection path such that the first and second protection paths do not have any common nodes or links." The Examiner asserts that these limitations are disclosed in *Walrand* by protection paths p1 (708) and p2 (712). However, *Walrand* specifically discloses and illustrates that path 708 runs from node Z1 to node S (*see* Col. 9, lines 2-5; Fig. 7) and that path 712 runs in the opposite direction between node Z3 and node S (*see* Col. 9, lines 5-7; Fig. 7). Therefore, referring to Figure 7 of *Walrand*, paths 708

and 712 have nodes Z1, Z2, and Z3 (as well as the links between these nodes) in common. Thus, *Walrand* cannot teach or suggest the above-quoted limitation.

In addition, Claim 1 recites that “generating the first protection path and generating the second protection path each comprise *decomposing* the telecommunications network *into a ring and at least one ear*.” As the Examiner points out, *Walrand* does not disclose these limitations. The Examiner asserts that these limitations are disclosed in *Chang* -- citing Figure 12, Column 13, lines 65-67, and Column 14, lines 1-15. This is the same assertion that the Examiner previously made with respect to *Chang*, which Applicants refuted in their previous Response. However, the Examiner has not addressed Applicants’ arguments in the present Office Action and simply restates the same assertions.

As Applicants previously have shown, neither Figure 12 nor the cited passages nor any other portion of *Chang* discloses that generating a first protection path and generating a second protection path each comprise decomposing the telecommunications network into a ring and at least one ear, as required by Claim 1. The cited passages and figure refer to two different four-fiber bidirectional APS self-healing rings (90.1 and 90.2) interconnected by a cross-connect 92. They do not refer to a telecommunications network being decomposed into a ring and at least one ear. Again, by way of example and without limitation, Applicants direct the Examiner’s attention to the discussion of network decomposition in the present Application with reference to FIGURES 2 and 3 on pages 9-12 of the “Detailed Description of the Invention.” For at least this additional reason, Claim 1 is allowable.

Furthermore, Claim 19 contains limitations similar to those discussed above with reference to Claim 1. Therefore, for the reasons provided above, Applicants respectfully request reconsideration and allowance of Claims 1 and 19, as well as the claims that depend from these independent claims.

In addition to depending from an allowable independent claim, several of the dependent claims also include additional limitations not found in the cited references. For example, and without limitation, Claim 5 recites “charting the ring horizontally beginning with the destination node and ending with the destination node.” For a teaching of this limitation, the Examiner

simply refers to *Chang*, Column 13, lines 65-67 and Column 14, 1-15. Again, the Examiner previously asserted this portion of *Chang* as a teaching of this limitation, and Applicants refuted this assertion in their previous Response. However, the Examiner has not addressed Applicants' arguments in the present Office Action. Again, Applicants respectfully fail to see how this cited passage is a teaching of the recited limitation. The cited material refers to Figure 12, which makes no disclosure or suggestion of charting the ring horizontally beginning with the destination node and ending with the destination node. Again, by way of example and without limitation, Applicants direct the Examiner's attention to the discussion of network decomposition and charting in the present Application with reference to FIGURE 3 on pages 11-12 of the "Detailed Description of the Invention." For at least this additional reason, Claim 5 is allowable. Since Claims 6 and 7 share this limitation, Claims 6 and 7 are allowable for at least this additional reason. Furthermore, Claims 6 and 7 include further limitations not addressed by the Examiner.

The Examiner also rejects Claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over the combined system of *Walrand* and *Chang* in view of U.S. Patent No. 5,949,755 issued to Uphadya et al. ("*Uphadya*"). In addition, the Examiner rejects Claims 22-24 and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over the combined system of *Walrand* and *Chang* in view of *Uphadya*. Claims 8-10, 22-24 and 26-29 depend from one of independent Claims 1 and 19 and are thus allowable at least because they include the limitations of either Claim 1 or 19, which have been shown to be in condition for allowance. For at least this reason, Applicants respectfully request reconsideration and allowance of Claims 8-10, 22-24 and 26-29.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that Claim 25 would be allowable if rewritten in independent form. However, Claim 25 depends from independent Claim 19, which is in condition for allowance, as discussed above. Accordingly, Applicants have not amended Claim 25.

CONCLUSION

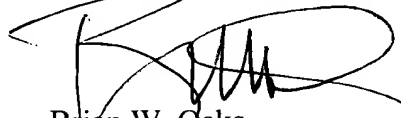
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants do not believe that any fees are due. However, the Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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